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REMARKS/ARGUMENTS

Claims 19-36 and 46-75 are pending in this application. Claims 19-36 have been rejected, and claims 46-75 were previously withdrawn. For at least the reasons stated below, Applicant asserts that all claims are in condition for allowance.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Claims 19-27 have been variously rejected under 35 U.S.C. § 102 as follows:

- a) 35 U.S.C. § 102(b) as being anticipated by Quicken on the "Turbotax for the Web";
- b) 35 U.S.C. § 102(b) based on the public use or sale of "Turbotax for the Web"; and
- c) 35 U.S.C. § 102(e) as being anticipated by Donlavage et al. (U.S. 2001/0034655 A1)

Because each and every element of every claim is not taught by either the "Turbotax for the Web" reference or the *Donlavage* reference as required by MPEP § 2131, the § 102 rejections are unsupported by the art and should be withdrawn. Applicants respectfully request consideration of the arguments below.

(1) § 102(b) Based on Anticipation by "Turbotax for the Web"

Claims 19-27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Quicken on the "Turbotax for the Web." The Office Action asserts, "'Turbotax for the Web' inherently disclosed the claimed features including storing user profiles (the user's data is stored remotely), the passwords, and other features."

At least because not every element of every claim is taught by the *Turbotax for the Web* reference, Applicant respectfully requests that the § 102 rejections be withdrawn. Specifically, *Turbotax for the Web* fails to disclose at least (a) receiving a record of a tax form across a network in response to a user request for the record, (b) maintaining a user profile on a customer database that identifies a tax form the user is expected to file, and (c) receiving a tax payment of the user by the government entity utilizing the network.

(a) The Reference Fails to Disclose Receiving a Record of a Tax Form Across a Network in Response to a Request From the User

The present claimed invention recites, "receiving from the user a request for the record of the tax form utilizing the network" and "sending the record of the tax form to the user across the network to the client computer," where "the record represents an indication that the tax form has been submitted." Specifically, this verification process of the present claimed invention includes requesting and receiving across a network a record of a tax form, where the record is distinct from

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the actually filed tax form. *Turbotax for the Web*, as described in *Intuit Press Release*, *TurboTax for the Web*, fails to teach this limitation.

The *Intuit Press Release*, *TurboTax for the Web* reference is exceedingly general and offers few details about the product it discusses, namely Quicken TurboTax for the WebSM. *Intuit Press Release*, *TurboTax for the Web* does not disclose or even mention requesting and receiving across a network a record of a tax form, where the record is distinct from the actually filed tax form.

The *Intuit Press Release*, *TurboTax for the Web* reference indicates that Quicken TurboTax for the WebSM “includes the same features...as the...TurboTax desktop software program...” However, as previously describe by Applicant in the Amendment and Response to Office Action dated December 10, 2003 and the Amendment and Response to Office Action dated May 17, 2004, the TurboTax desktop software program also fails to teach these limitations. Specifically, the previously cited TurboTax desktop software transmits a tax return over the Internet to Intuit’s Electronic Filing Center, where the tax return is then transferred to the IRS. However, there is no description in the art of record (*see*, e.g., “User’s Guide for TurboTax and TurboTax Deluxe”) stating that the TurboTax desktop software performs the claimed verification process—which includes requesting from a government entity a record of a tax form across a network and receiving on a client computer the record of a tax form across the network, where the record is distinct from the actually filed tax form. Although “User’s Guide for TurboTax and TurboTax Deluxe” describes an “IRS electronic acknowledgement” of filing a tax return, *see* p. 39, the reference does not describe receiving the record of a tax form on a client computer across the network in response to a user request for the record of the tax form as claimed.

For at least these reasons, the cited reference fails to disclose every element of claims 19-27—let alone show “the identical invention...in as complete detail as is contained in the...claim” as required by MPEP § 2131—and Applicant respectfully requests that the § 102 rejection be withdrawn.

(i) Office Action Response Regarding “Receiving a Record of a Tax Form Across a Network in Response to a User Request”

In response to the above arguments, the Office Action first countered:

Based upon the entire record, the Examiner finds that one of ordinary skill in this art would recognize that when the tax information is sent by the user either by direct typing or other means (e.g. computer file), the receiving end must receive a record of a tax form across a network in response to a user input request for the record. It is the user who

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requests to send the information. If the user does not desire to send the tax information, it will not be sent.

Office Action, dated August 4, 2004, p. 4. Applicant respectfully disagrees with this assessment, as it clearly fails to recognize two distinctly claimed steps: (1) filing the tax form with the government entity, and (2) verifying that filing by requesting the record of the tax form from the government entity and then sending the record to the user. The above characterization of the claimed steps—e.g., “when the tax information is sent by the user...the receiving end must receive a record of a tax form...”—demonstrates a misunderstanding of the data flow in present invention.

The presenting claimed invention recites (1) “filing the tax form with a government entity,” and (2) verifying that filing, including receipt by the government entity of a request from the user for a record of the tax form, and submission of the record of the tax form to the user. In other words, after the tax form is filed with the government entity, the user requests, from the client computer to the government entity, a record of the tax form over the network. Then, the record of the tax form is sent to the user and the client computer. Moreover, the “record of the tax form,” which “represents an indication that the tax form has been submitted,” is clearly distinct from the tax form itself, which is electronically filed with the government entity.

Thus, the actual claimed invention is quite distinct from Office Action’s characterization that “when the tax information is sent by the user...the receiving end [the government entity] must receive a record of a tax form...in response to a user input request for the record.” Nowhere do the claims describe the government entity receiving a record of a tax form, which is an indication that the form has been submitted, in response to a user request for the record, as described in the Office Action. It is the user and the client computer that receive the record in response to the user request, as claimed.

Moreover, sending tax information, or the tax form, to the government entity is a wholly distinct step from requesting and receiving from the government entity a record of the tax form. There is nothing inherent in filing a tax form with a government entity that would require that the government “must receive a record of a tax form across a network in response to a user input request for the record,” as described in the Office Action. As disclosed in *Turbotax for the Web*, one may clearly file a tax form with a government entity without subsequently requesting a record of the tax form from the government entity as claimed in the present invention.

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(ii) Office Action Response Regarding "Requesting a Record of a Tax Form from the Government Entity"

In response to Applicant's argument that the reference fails to disclose, "requesting from a government entity a record of a tax form across a network and receiving on a client computer the record of a tax form," the Office Action further argued:

Whether or not this is true at this time is immaterial because this phrase is not found in the claims [sic]. To be clear, the Examiner is relying on a broad yet reasonable definition of "record" (as noted in the previous office action(s)) and not Applicant's definition of record."

Office Action, dated August 4, 2004, p. 5. Applicant respectfully disagrees with this assessment, because (1) it clearly fails to address all of the recited claim limitations, and (2) it clearly fails to recognize the data flow of the claimed invention as described above.

As to the claim limitations, the Office Action states, "Examiner is relying on a broad yet reasonable definition of 'record'...and not Applicant's definition of record." However, regardless of what definition of "record" Examiner implements, Examiner cannot ignore specific claim limitations that characterize the "record." Specifically, the claims recite a "record of the tax form" where "the record represents an indication that the tax form as been submitted." Nowhere does the cited reference disclose such a record, nor does the chosen definition of "record" affect this determination. A valid 35 U.S.C. § 102 rejection must teach each and every element of every claim, as required by MPEP § 2131. Thus, notwithstanding the selected definition of "record," nowhere does the reference teach this limitation—"the record represents an indication that the tax form as been submitted"—nor has the Office Action cited where the reference purportedly teaches this limitation.

As for the information flow, the Office Action asserts that the claims do not recite, "requesting from a government entity a record of a tax form across a network and receiving on a client computer the record of a tax form." Yet, as describe above, the claims clearly do recite this verification process: after the tax form is filed with the government entity, the user requests, from the client computer to the government entity, a record of the tax form over the network. Then, the record of the tax form is sent to the user and the client computer. See, e.g., Claim 19 (reciting "receiving from the user a request for the record of the tax form utilizing the network, wherein the request is transmitted across the network from the client computer to the government entity;...and sending the record of the tax form to the user across the network to the client computer upon the successful authentication of the identity of the user.).

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(b) The Reference Fails to Disclose Maintaining a User Profile on a Customer Database

The present claimed invention further recites, “maintaining an electronically stored profile for a user in a customer database, wherein the profile identifies a tax form the user is expected to file...” *Turbotax for the Web* fails to disclose this limitation.

The *Intuit Press Release, TurboTax for the Web* reference describes how, “relevant information from [the taxpayer’s previous] tax year return can be transferred into their [current] return to save time and increase accuracy even more. In addition, Quicken 2000 users can import relevant tax data into TurboTax for the Web to reduce this year’s data entry.” However, there is no description in *Intuit Press Release, TurboTax for the Web* or “User’s Guide for TurboTax and TurboTax Deluxe” of electronically storing a profile that identifies a tax form the user is expected to file as claimed. Nowhere does *Intuit Press Release, TurboTax for the Web* disclose “the identical invention...in as complete detail as is contained in the...claim” as required by MPEP § 2131.

This argument was made in the Amendment and Response to Office Action dated May 17, 2004, but the Office Action failed to address it. The Office Action merely asserted that “Applicant’s remaining arguments have been considered but are found unpersuasive.” Office Action, dated August 4, 2004, p. 5. This cursory response does not “include a rebuttal of any arguments raised in the applicant’s reply” or clearly develop the grounds of rejection “to such an extent that applicant may readily judge the advisability of an appeal” as required by § MPEP 706.07. Accordingly, the Office Action has failed to establish a valid final rejection, and Applicant respectfully requests a rebuttal to the above arguments, or concession of the above arguments and removal of the finality of the rejection.

For these additional reasons, the cited reference fails to disclose every element of claims 19-27, and the Office Action has failed to establish a valid 35 U.S.C. § 102 rejection. Applicant respectfully requests that the § 102 rejections be withdrawn.

(c) Dependent Claims 20 and 29: The Reference Fails to Disclose Receiving a Tax Payment Utilizing the Network

The present claimed invention recites, “receiving a tax payment of the user by the government entity utilizing the network.” Nowhere does the cited reference teach or suggest this limitation, nor does the Office Action assert where this limitation is taught or even that the reference teaches this specific limitation. Although *Turbotax for the Web* generally describes filing a tax return where the user may receive a refund from a government entity, the reference fails to describe receiving a tax payment from the user utilizing the network. For example, the cited

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TurboTax software only describes a user physically mailing a tax payment to the IRS, not utilizing a network. *See, e.g.*, "User's Guide for TurboTax and TurboTax Deluxe," p. 40 ("If you owe federal taxes, you must also mail Form 1040-V to the IRS with your payment. This payment must be postmarked by the April 15..."). Moreover, the rejection under 35 U.S.C. § 102(b) for anticipation by *Turbotax for the Web* is a mere three sentences long, and fails to offer a complete or developed explanation of how the reference teaches each and every claimed element of claims 20 and 29. Office Action, dated August 4, 2004, p. 3.

For this additional reason, the cited reference fails to disclose every element of claims 20 and 29, and the Office Action has failed to establish a valid 35 U.S.C. § 102 rejection. Applicant respectfully requests that the § 102 rejections be withdrawn.

(2) § 102(b) Based on Public Use or Sale of "Turbotax for the Web"

Claims 19-27 are rejected under 35 U.S.C. § 102(b) based on the public use or sale of *Turbotax for the Web*. For at least the reasons stated above, this reference fails to disclose each and every element of every claim. Accordingly, the § 102 rejections are unsupported by the art and should be withdrawn.

(3) § 102(e) Based on Anticipation by Donlavage

Claims 19-27 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Donlavage* et al. (U.S. 2001/0034655 A1) (hereinafter, *Donlavage*). *Donlavage* fails to disclose every element of every claim, and for at least this reason, Applicant asserts that this rejection should be withdrawn.

As previously described, the present claimed invention recites, *inter alia*, (1) "maintaining an electronically stored profile for a user in a customer database, wherein the profile identifies a tax form the user is expected to file...", and (2) "electronically completing a tax form, wherein completing the tax form includes automatically filling out the tax form based on the profile and the additional tax-related data."

In contrast, *Donlavage* describes a method for providing tax payment data from a remote end user workstation to a tax collection system. *Abstract*. Specifically, *Donlavage* discloses providing the tax payment data by displaying available taxing authorities to the user and allowing the user to select one of the taxing authorities, inputting and transmitting the payment data to the tax collection system, processing the data at a server of the tax collection system, transmitting payment data to the tax collection system, and transmitting a message of acceptance or rejection of the tax payment data.

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See, page 1, ¶ 3-6. The reference further indicates that the system “provides the capability for an end user to import a predefined ASCII file containing taxpayer state tax payment data.” *Id.*

However, nowhere does the reference disclose (1) maintaining an electronically stored profile for a user where the profile identifies a tax form the user is expected to file, or (2) electronically completing a tax form based on both a user profile and additional tax-related data, as claimed. Although *Donlavage* describes importing an ASCII file containing the taxpayer’s state payment data, this teaching does not disclose the claimed limitation of completing a tax form based on two sources, nor does it disclose the claimed limitation of prompting the user for the “additional tax-related data [that] is not included in the profile” but which is anticipated as being “required for completing the tax form the user is expected to file.”

For at least these reasons, the cited reference fails to disclose every element of claims 19-27, and Applicant respectfully requests that the § 102 rejection be withdrawn.

(a) Office Action Response to Arguments

These arguments were made in the Amendment and Response to Office Action dated May 17, 2004, but the Office Action failed to address them. The Office Action merely asserted, “Applicant’s remaining arguments have been considered but are found unpersuasive.” Office Action, dated August 4, 2004, p. 5. This cursory response does not “include a rebuttal of any arguments raised in the applicant’s reply” or clearly develop the grounds of rejection “to such an extent that applicant may readily judge the advisability of an appeal” as required by § MPEP 706.07. Accordingly, the Office Action has failed to establish a valid final rejection, and Applicant respectfully requests a rebuttal to the above arguments, or concession of the above arguments and removal of the finality of the rejection.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 28-36 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over “Turbotax for the Web or *Donlavage*.” Specifically, the Office Action asserts that the patentability of claims 28-36 stands or falls with the patentability of claims 19-27. The cited references do not teach or suggest all the claim limitations as required by MPEP § 2143.

As demonstrated above, neither *TurboTax for the Web* nor *Donlavage* discloses all of the claim limitations. Further, the § 103 rejection is based on Turbotax for the Web or *Donlavage*, not the combination thereof, and the Office Action has not cited any suggestion or motivation to combine

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or modify either reference. Accordingly, Applicant respectfully requests that Examiner withdraw the § 103 rejection.

Moreover, these arguments were also made in the Amendment and Response to Office Action dated May 17, 2004, but the Office Action failed to address them. The Office Action merely asserted that "Applicant's remaining arguments have been considered but are found unpersuasive." Office Action, dated August 4, 2004, p. 5. This cursory response does not "include a rebuttal of any arguments raised in the applicant's reply" or clearly develop the grounds of rejection "to such an extent that applicant may readily judge the advisability of an appeal" as required by § MPEP 706.07. Accordingly, the Office Action has failed to establish a valid final rejection, and Applicant respectfully requests a rebuttal to the above arguments, or concession of the above arguments and removal of the finality of the rejection.

CONCLUSION

Applicant submits that all pending claims are allowable and respectfully requests that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (612) 607-7386. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Reference 60021-357601).

Respectfully submitted,

By Christopher R. Hilberg
Christopher R. Hilberg, Reg. No. 48740
Customer No. 29838

Oppenheimer Wolff & Donnelly, LLP
45 South Seventh St.
Plaza VII, Suite 3300
Minneapolis, MN 55402-1609
Telephone: 612-607-7386
Facsimile: 612-607-7100
E-mail: CHilberg@oppenheimer.com